

## **REMARKS**

### **Overview**

Claims 1, 3-16 and 18-89 are pending in the present application. The most recent Office Action has been carefully reviewed. The present response is an earnest attempt to advance prosecution of the present application. Reconsideration is respectfully requested.

### **Allowable Claims**

Claims 25-27, 62-64, and 79-81 have been found to be allowable if appropriately reworded to include the limitations of any base claim and intervening claims. Applicant gratefully acknowledges the finding of allowable subject matter in the application. However, Applicant respectfully submits that additional claims are allowable over the cited art and respectfully requests reconsideration of those claims for the reasons expressed below.

### **35 U.S.C. § 103 Rejections**

The only rejections on the merits are under 35 U.S.C. § 103 for obviousness. There are no rejections under § 102 for anticipation, therefore, no reference has been indicated to substantially identically disclose the claimed invention.

The most recent action has withdrawn prior rejections and included new obviousness rejections based on Applicant's own U. S. Patent No. 6,340,790 (Gordin et al) in view of newly cited Fox, U. S. Patent No. 4,019,301 as a secondary reference by itself or in combination with previously cited Oakes, U. S. Patent No. 3,968,561 or previously cited Swanson, U. S. Patent No. 4,092,079. Fox has been carefully reviewed. Each of the new obviousness rejections is respectfully traversed for at least the following reasons.

A *prima facie* showing of obviousness requires that there be a teaching or suggestion to combine the references and, once combined, that combined teaching at least appear to show or suggest the claimed invention to one of ordinary skill in the art.

The primary reference, Gordin '790, is the Applicant's own prior invention. As discussed in detail in prior responses, its Figure 3, for example, certainly does disclose a pole having multiple sections. The pole is tapered. The multiple sections are slip fit together at adjacent ends to create the complete pole. The secondary reference, Fox, certainly does disclose a "corrosion-resistant encasement for structural members".

The Office Action acknowledges Gordin '790 has no disclosure of an independent plastic covering on a pole, but concludes "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gordin by adding the protective plastic covering of Fox in order to prevent corrosion." Office Action, page 2.

It appears the basic dispute is whether there is any *prima facie* showing of any suggestion in either Gordin or Fox of combining the two concepts together and, even if so, whether the combined teachings teach or suggest the precise claimed invention of the Applicant.

It is respectfully submitted that there is no such *prima facie* showing of suggestion of combination of Fox and Gordin US 6,340,790. There is no reference or citation to any part of Gordin '790 that suggests any additional corrosion protection is needed for those poles other than treatment of the metal (e.g., galvanization). Indeed, the Gordin '790 patent discusses some of the issues and problems that must be considered when using substantially tall poles to elevate objects. For example, columns 2 through 6 describe how there must be a careful balancing of strength and rigidity versus minimization of weight and effective projected area for decreased wind load. It also describes the factor of economics. Poles need to be as cheap as possible to

make them economically attractive. But there is simply no mention or suggestion that any additional protection is needed for such poles other than galvanization for metal.

On the other hand, Fox describes corrosion resistant structural members such as pilings that are placed in or below water. It mentions in its columns 1 and 2 other's attempts to make such pilings corrosion resistant. It also talks about additionally using the encasement to reconstruct worn portions "to achieve the original structural integrity of the structure" (Abstract). The Fox patent explicitly states its solution is an encasement that has an outer encasement member with a gap between it and the piling. The gap is filled with "inert material" in the nature of a filler that bonds the encasement member to the structural member. It mentions epoxy resin (column 4, lines 1-9) as one example of the filler. Fox, therefore, creates a multi-layered, multi-piece encasement that is bonded to the piling and becomes integral with the piling.

Therefore, Fox is similar, if not identical, in relevant teaching to other previously cited references of record such as Swanson U.S. Patent No. 4,092,079 and Kozikowski U. S. Patent No. 4,543,764, which repair poles by having an outer sheet-like form into which some epoxy filler can be injected. The epoxy filler not only seals off the surface of the piling or pole but cures and becomes a load bearing integral part of that elongated piece. The outer shell, in a large part, is just a form or casing into which the foam or epoxy mixture is injected to set up.

Applicant's first main point is that no suggestion or teaching is found in the primary cited Gordin reference suggesting the need for any additional structure on the exterior of the pole. Indeed, the opposite is suggested because the metal is galvanized, and there is a need to increase the size and weight of poles, especially in outdoor environments, to which would increase wind load and cost. On the other hand, there is no teaching or suggestion of using a multi-component encasement combination such as Fox, which is focused on keeping salt water away from pilings

in the water, with tall poles that are above the ground. There is no teaching, suggestion or motivation to add in the substantial size and weight of such a comprehensive encasement method to thin-walled, tall, metal, above-ground pole.

In an obviousness evaluation, the problem solved or addressed by a claimed invention is always relevant. Therefore, it is respectfully submitted a *prima facie* showing that Gordin and Fox teach or suggest combination has not been established. The claimed invention relates to a counter-intuitive step -- adding cost and weight to a tall pole that has been designed to support structures high above the ground.

But, moreover, even if those teachings (Gordin '790 and Fox) are combined, they do not show each material limitation of the claimed invention. Consider, for example, Applicant's claim 1. The Office Action alleges that "Fox discloses a wrapped plastic covering for metal members (secured for movement)." Office Action, page 2. Instead, what Fox discloses is an encasement method using a portable or pumpable mixture or slurry poured into the gap between a piling and the outer encasement member. The outer encasement member contains that portable or pumpable semi-solid or liquid slurry until it sets up and hardens and bonds. In contrast, Applicant's claim 1 describes "a covering layer . . . in conforming relationship over a pole exterior". The epoxy slurry is in conforming relationship to the exterior of the piling in Fox. The outer encasement 10 is not -- it is intentionally spaced apart from the exterior of the piling.

This is a meaningful difference. Applicant's specification explicitly describes the thin plastic covering over the exterior of the pole does not materially add to wind load or weight. Also, it does not function to add structural rigidity or load bearing capacity to the pole. In contrast, Gordin '790 says nothing about adding to the exterior of the pole and Fox adds a multi-layered, heavy encasement.

It is therefore earnestly and respectfully submitted that, when combined, Gordin and Fox do not teach or suggest Applicant's claimed invention. Fox teaches a bonded hardened added structural encasement of semi-solid or liquid phase substance in an outer form which is spaced from the underlying piling or structure. There is no suggestion or teaching that only the outer encasement sleeve 10 of Fox be used or that it be conformed directly at the exterior surface of what it surrounds.

It is therefore respectfully submitted that the combination of Gordin in view of Fox does not present a *prima facie* case of obviousness of any of the claims which have been rejected under § 103.

However, to try to advance prosecution of the present invention, amendments have been made to several of the claims in a sincere effort to clarify meaningful distinctions between the claims and the cited references.

For example, claim 1 has been amended to specify that the pole has a side wall with a thickness of a fraction of an inch. The covering layer has been clarified to be of "plastic sheet material having inner and outer sides". The conforming relationship of covering layer to the pole is defined as "mounted in conforming relationship over a pole at the exterior of at least a substantial portion of the length of the pole". This is intended to clarify that it is that sheet-like thin plastic cover that is conformed directly at the exterior surface of the thin walled metal hollow pole. This is intended to more clearly differentiate claim 1 from references such as Fox which, again, teach multi-layer encasement using originally semi-solid or liquid phase slurry epoxy, concrete, or the like to support or pump in the gap between and outer form and the inner structural member and allow to set up and bond to essentially strengthen the inner member and

become an integral part of it. In comparison, Applicant's claim 1 defines a sleeve cover thin plastic right at the exterior of the pole.

It is therefore respectfully submitted dependent claims 3-16 and 18-41 are patentable over Gordin in view of Fox for the same reasons expressed in support of claim 1.

Independent claim 42 is similar to claim 1, and has been revised to clarify the same distinctions as discussed with respect to claim 1, but is a description of that concept in method form. It is respectfully submitted there is no teaching in Gordin or Fox of a method that utilizes the thin plastic sleeve as a cover directly at the exterior of a thin wall metal hollow pole.

Claims 43-53 are dependent on claim 42 and are submitted to be allowable for the reasons expressed in support of claim 42.

Independent claim 54 is an apparatus claim and has similar limitations to claim 1 but adds the limitation that the thin plastic cover is comprised of "a plurality of independent members arranged along the pole". For the same reasons as expressed in support of the earlier claims, it is submitted claim 54 is not obvious in light of Gordin in view of Fox.

Claim 55 is dependent on claim 54 and submitted to be allowable for the same reasons. Moreover, claim 55 describes the sheet material for the cover in trapezoidal shape such that it can fit around a tapered part of a pole. This is neither taught nor suggested in either Gordin or Fox.

Independent claim 56 is similar to claim 1 except it includes the limitation that the pole is tapered and the thin plastic cover can be formed into a truncated cone that can conform right at the exterior of the pole. For similar reasons as expressed above, it is submitted independent claim 56, as well as its dependent claims 57-72 are allowable over Gordin in view of Fox.

Independent claim 73 is similar to claim 56 as it includes a tapered pole but adds the concept that the covering layer of thin plastic material can be wrapped or placed around the pole.

There is no teaching in Gordin or Fox of any wrappable material. Therefore, claim 73 and its depending claims 74-89 are submitted to be allowable over Gordin in view of Fox.

It is noted that claims 58 and 75 have been cancelled without prejudice.

Applicant has attempted to make the claim language clear that the thin plastic material is a cover right at the exterior of the pole to distinguish it from the cited references such as Fox. It is respectfully submitted that the claim language presently submitted does that. If the Examiner has any other suggestions as to make this clear, Applicant would appreciate any such suggestion if the amended claims are still not found allowable.

### **Conclusion**

It is respectfully submitted all matters raised in the Office Action have been addressed and remedied and that the application is in form for allowance. Favorable action is respectfully requested.

This is a request under the provision of 37 CFR § 1.136(a) to extend the period for filing a response in the above-identified application for one month from July 20, 2007 to August 20, 2007. Applicant is a large entity; therefore, please charge Deposit Account number 26-0084 in the amount of \$120.00 to cover the cost of the one month extension. Any deficiency or overpayment should be charged or credited to Deposit Account 26-0084. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and passage to issuance is respectfully requested.

Respectfully submitted,

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